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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,625	07/16/2001	Peter Kufer	07258-023001	3114

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Pillsbury Winthrop
50 Freemont Street Fifth Floor
San Francisco, CA 94105-2230

EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,625

Applicant(s)

KUFER ET AL.

Examiner

MISOOK YU, Ph.D

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,8-18,24,25 and 27-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 7, 19, 20, 21, 22, 23, and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/23/05 has been entered.

Election/Restrictions

Claims 3, 5, 8-18, 24, 25, and 27-41 remain withdrawn for reason of record from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Further, claims 3, and 5 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claims 1-41 are pending. Claims 1, 2, 4, 6, 7, 19, 20, 21, 22, 23, and 26 are examined on merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, Withdrawn

The rejection of claim 26 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102, Maintained

Claims 1, 2, 4, 6, 7, 19, 20, 21, 22, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by Muller et al., (30 January 1998, a copy provided with ISR, FEBS Letters, vol. 422, pages 259-264) as evidenced by WO 97/01580 (a copy provided with ISR).

The claims are interpreted as drawn to a heterodimer i.e. a multifunctional compound comprising two monomers, wherein the first monomer comprises CH1 domain linked to a polypeptide, and the second monomer comprises CL1 linked to a different polypeptide, wherein the heterodimer is not formed by interaction between the two polypeptides but formed by CH1 domain and CL domain, wherein said two polypeptides bind different receptors or have different ligand functions (claim 1), wherein claim 2 describes how the two polypeptides are linked to either said CH1 domain or said CL1 domain i.e., C-and/or-N-terminal, wherein claim 4 further limits said heterodimer to have four functional domains, wherein claim 6 further limits at least one of the two polypeptides to be a scFv-fragment, wherein claim 7 further limits at least one of the two polypeptides to have an antigen binding region specific for a tumor associated antigen, wherein claim 19 further limits said CL1 domain to be from kappa chain of an immunoglobulin, wherein claims 20-22 further limit how said CH1 domain or said CL domain is connected to the different polypeptides, namely by a polypeptide linker (claim 20), an Ig-hinge region (claim 21), or an IgG hinge region (claim 22), wherein claim 26 further limits said CH1 domain be linked to a histidine tag.

Applicant argues that the prior art of record does not teach that the product is not expressed in and secreted by a mammalian host cell as the claim 1 as amended requires. This argument is fully considered but found unpersuasive because the how the claimed product is made is not given patentable weight. The claimed invention is drawn to product per se.

As stated before in the previous Office actions, Muller et al., teach a heterodimer comprising two monomers, wherein the first monomer comprises CH1 domain linked via C-and/or-N-terminal to two functional domains i.e. VH and VL functional domains of anti-EGF-R scFv fragment, and the second monomer comprises CL1 linked via C-and/or-N-terminal to two other functional domains i.e. VH and VL functional domains of anti-CD2 scFv fragment (total four functional domains in the multifunctional compound, as specified instant claim 4), wherein the two different polypeptides (i.e. anti-EGF-R scFv fragment and anti-CD2 scFv fragment) lack an intrinsic affinity for one another, wherein the heterodimer is formed by a disulfide bond between the CH1 domain of the first monomer and the CL domain of the second monomer (note Fig.1, the heading "Materials and methods" at pages 259-261, and Fig. 2), wherein at least one of the two monomers is to be able to bind a tumor associated antigen (note page 259, right column, 1st paragraph, where it teaches "miniantibodies capable of binding to the EGR receptor" that is "overexpressed by a wide range of tumors"), wherein said CL1 domain is from the kappa type chain of an immunoglobulin (note line 8 under the sub-heading "plasmid construction" at page 259, left column), wherein the CH1 domain or the CL domain is connected to the different four functional domains, at least two of the four

functional domains having a ligand function to a EGF receptor (note page 259, 1st paragraph), namely by a polypeptide linker, or an Ig-hinge region, more specifically an IgG hinge region (note line 8 under the sub-heading “plasmid construction” at page 259, left column and Fig. 1B), wherein the CH1 domain is linked to a histidine tag (note line 2 from bottom of page 259, left column under the sub-heading “plasmid construction” and Fig. 1B).

The recitation of “expressed in and secreted by a mammalian host cell” in the amended claim 1 does not limit either the function and/or structure of the claimed multifunctional compound. In other words, the instant claim 1 is a product by process claim. As stated in the previous Office actions, the supporting document, WO 97/01580 demonstrates that a multifunctional compound can be made in a mammalian host cell as a secretable and fully functional heterodimer of two polypeptide chains before the effective filing date of the instant application. 97/01580 at page 16 especially lines 16 “a mammalian” host cell can be use to produce an engineered fully functional heterodimer antibody, and also teach at page 18 especially lines 4-20 a secretion signal that could be used in a mammalian expression system. Thus, the claimed multifunctional compound could be producible in a mammalian host cell as a secretable and fully functional heterodimer of two polypeptide chains. The Office emphasizes that WO 97/01580 is not cited to explain the structural limitation of the claimed multifunctional compound.

As stated in the previous Office actions, the recitation of a process limitation in claim 1 is not viewed as positively limiting the claimed product absent a showing that

Art Unit: 1642

the process of making recited in claim 1 imparts a novel or unexpected property to the claimed product, as it is assumed that equivalent products are obtainable by multiple routes. The burden is placed upon the applicants to establish a patentable distinction between the claimed product and the product of the reference.

The method in which the heterodimer is produced is immaterial to its patentability. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process in a claim is the same from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP 2113.

Claim Rejections - 35 USC § 103

Claims 1, 2, 4, 6, 7, 19, 20, 21, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al., (30 January 1998, a copy provided with ISR, FEBS Letters, vol. 422, pages 259-264) in view of Pluckthun and Pack (1997, Immunotechnology, vol. 3, pages 83-105).

Claims 1, 2, 4, 6, 7, 19, 20, 21, 22, 23 and 26 are interpreted as drawn to a heterodimer i.e. a multifunctional compound comprising two monomers, wherein the first monomer comprises CH1 domain linked to a polypeptide, and the second monomer comprises CL1 linked to a different polypeptide, wherein the linking is done by the **upper hinge region of human IgG3** (claim 23). See the interpretation of claims 1, 2, 4, 6, 7, 19, 20, 21, 22, 23 and 26 above for further details.

Applicant argues that Muller et al., do not teach all of the limitation of claims for the reasons given traversing 102 (b) rejection above. However, Muller et al., stand as an 102 (b) art for the reasons given above.

As stated above in the rejection of 102(b), and also in the previous Office action, Muller et al., teach a multifunctional compound comprising two monomers, wherein the first monomer comprises CH1 domain linked to a polypeptide, and the second monomer comprises CL1 linked to a different polypeptide with all the structural limitations of claims 1, 2, 4, 6, 7, 19, 20, 21, 22, and 26. Muller et al., at the last sentence under the heading "Introduction" also teach why one of ordinary skill would be motivated to use a human sequence i.e. to reduce immunogenicity in a human subject.

Muller et al., do not specifically teach "the upper hinge region of human IgG3".

However, Pluckthun and Pack teach at page 89, left column, 1st paragraph "the use of hinge regions creates a spacing, hinge bending and rotational freedom of the associated scFv fragments, similar to the Fv-arms of a complete antibody...but with a fraction of its molecular weight. This was achieved by not adding the dimerization handle directly to the scFv fragment, but rather separated **by the upper hinge** from murine or **human Ig3**, known to lead to a flexible arrangements of domains". Further, Pluckthun and Pack teach at the paragraph bridging pages 95-96 that a human IgG hinge region has been used for therapeutic application, which requires reduced "immunogenicity" in a human clinical application.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to substitute the linkers of Muller et al., with

Art Unit: 1642

the upper hinge region of human IgG3 taught by Pluckthun and Pack, to make a multifunctional compound. This would have been accomplished with a reasonable expectation of success since combination of Muller et al., (Jan. 1998) and Pluckthun and Pack (1997) teach how to make each elements of the claimed invention. One of ordinary skill in the art would have been motivated to make and use the claimed multifunctional compound using the upper hinge region of human IgG3 as the linker because Pluckthun and Pack teach that the upper hinge region of human IgG3 is good for reducing immunogenicity in a human patient and the human IgG3 is also good for its flexibility.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

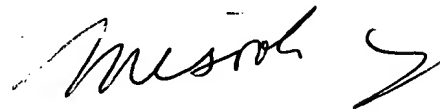
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Application/Control Number: 09/744,625
Art Unit: 1642

Page 9

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Business Center (EBC) at 866-217-9197 (toll-free).

MISOOK YU, Ph.D.
Examiner
Art Unit 1642

A handwritten signature in black ink, appearing to read "Misook Yu", with a stylized flourish at the end.